

Appl. No. 10/002,100  
Amdt. Dated March 1, 2004  
Reply to Office Action of December 3, 2003

Attorney Docket No. 81839.0106  
Customer No.: 26021

### **REMARKS/ARGUMENTS**

Claims 1, 6 and 7 are pending in the application. By this amendment, claims 1 and 6 are being amended in order to improve their form. No new matter is involved.

In paragraph 2 which begins at the bottom of page 2 of the Office Action, claims 1, 6 and 7 are rejected under the 35 U.S.C. § 102(b) or 102(e) as being anticipated by admitted prior art, with reference being made to pages 1-3 of the specification. In paragraph 4 which begins on page 4 of the Office Action, claims 1 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent 5,756,399 of Hajime et al. in view of U.S. Patent 5,800,725 of Kato et al. In paragraph 5 on page 5 of the Office Action, claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hajime/Kato and further in view of the admitted prior art. These rejections are respectfully traversed, particularly in view of the claims as amended herein.

The Examiner's response to the arguments made by Applicant in the prior Amendment is set forth in paragraph 6 which begins at the bottom of page 5 of the Office Action. As stated therein, Applicant argued that the claimed end product has no grinding striations on the front surface side but has grinding striations 4 on the back surface side while the applied art would have grinding striations remaining on the front surface because the front surface is subjected to a grinding step. This is said to be unpersuasive because Applicant has not provided factual evidence to show this. Furthermore, and in response to Applicant's argument that the references failed to show certain features of the invention, it is noted by the Examiner that the features upon which Applicant relies (i.e., the end product has no grinding striations on the front surface side but has grinding striations 4 on the

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back surface side) are not recited in the rejected claims. It is further stated that although the claims are interrupted in light of the specification, limitations from the specification are not read into the claims.

In response to these arguments, Applicant is amending the claims so as to recite that the front surface of the wafer has no grinding striations but the back surface has grinding striations. More specifically, claim 1 is being amended herein to recite "whereby the front surface of the wafer has no grinding striations but the back surface of the wafer has grinding striations". A like limitation is being added to claim 6 as amended herein. Claim 7 depends from claim 6 so as to contain this limitation as well.

Therefore, the feature of the present invention said in the Office Action to be missing from the claims, is now present in the claims.

As to the statement in the Office Action that Applicant has not provided factual evidence, Applicant has already explained that in the cited references the front surface of the wafer is subjected to a grinding step. As originally described on page 2 of the present application, grinding striations remain as micro roughness having a PV value of about 30-50nm and intervals of about 1-10mm on the surface of the wafer subjected to a grinding step, even after the wafer is polished. Also, the example according to the present invention shows the data that because the front surface of the wafer is polished without being subjected to a grinding step, the front surface has no grinding striations, and after the back surface of the wafer is subjected to a grinding step, the backside is subjected to double side polishing. However, on the back surface, there remain grinding striations as micro roughness having a PV value of about 30-50nm and intervals of about 1-10mm (see the example in the present specification, and in particular on page 17 thereof).

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Thus, in the case of the cited references, after the front surface is subjected to a grinding step, the front surface is polished and grinding striations remain on the front surface.

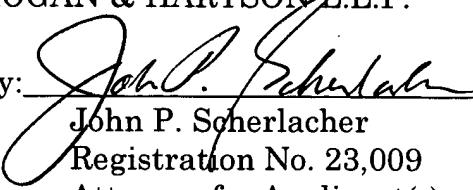
Therefore, and as discussed above, claims 1 and 6 as amended herein are submitted to clearly distinguish patentably over the prior art. Claim 7 depends from and contains all of the limitations of claim 6 so as to also distinguish over the art. In addition, claim 7 further defines claim 6 in terms of the micro roughness on the back surface having PV value of 30-50nm and intervals of 1-10 mm. Accordingly, claims 1, 6 and 7 patentably distinguish over the prior art.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 337-6846 to discuss the steps necessary for placing the application in condition for allowance.

If there are any fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1314.

Respectfully submitted,  
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